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4-19-04
me**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Glenn E. RIGGS et al.
Application No.: 09/915,301
Filing Date: July 27, 2001
Title: TRANSPORT LOGISTICS SYSTEMS AND METHODS
Art Unit: 3623
Examiner: Susanna Meinecke Diaz

**PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT MADE
AFTER APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

Applicant acknowledges receipt of an Office Communication dated March 12, 2004 stated to be responsive to Applicant's Appeal Brief filed on January 4, 2004. The Communication does not contain an Examiner's Answer and does not otherwise address the patentability of the claims of this application, but instead contains a new restriction requirement. Applicant therefore respectfully files this Petition to request that the restriction requirement be withdrawn as procedurally improper, a violation of due process, and inconsistent with current Patent Office regulations and policy.¹

¹ Applicants believe that the authority to decide this Petition has been delegated to the Technology Center Director pursuant to MPEP 1002.02(c), Item 8, concerning appealed patent applications before transfer of jurisdiction to the Board of Patent Appeals and Interferences. Applicants reserve the right to assert that the Director does not have the statutory authority to make restriction requirements in, or more broadly, to assert jurisdiction over applications on appeal to the Board of Patent Appeals and Interferences.

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Factual Background

This application was filed on July 27, 2001. The first Office Action was mailed by a first Examiner on January 15, 2003. The Office Action included the Examiner's consideration of two Information Disclosure Statements (PTO-1449), a Notice of References Cited (PTO-892) and a disposition of claims that consisted of a rejection under Section 101 and rejections of all of the pending claims (claims 1-45) as being anticipated or rendered obvious by prior art.

Applicant filed a response to the Office Action on April 15, 2003. The first Examiner mailed a second Office Action on July 11, 2003 which was made final and included another Notice of References Cited (PTO-892) and again a disposition of claims that consisted of a rejection under Section 101 and rejections of all of the pending claims 1-45 as being anticipated or rendered obvious by prior art. The second final Office Action was mailed to the wrong address. A third Office Action was mailed to the correct address by a second Examiner (who replaced the first Examiner) on July 31, 2003. The third Office Action was substantively the same as the second Office Action and was also made final.

A personal interview was conducted on August 25, 2003 between the undersigned attorney for applicants, the second Examiner and her Supervisory Primary Examiner (SPE). A number of different issues were discussed in the interview, including concerns by applicants that the final Office Action was incomplete and the rejection under Section 101. On September 2, 2003, applicants filed a Request for Complete Office Action and a Supplemental Amendment to address the rejection under Section 101. In an Advisory Action mailed on September 23, 2003, the Request for Complete Office Action was denied but the Supplemental Amendment was

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entered and was indicated to overcome the rejection under Section 101.

On October 30, 2003, applicants filed a timely Notice of Appeal and also filed a Request for Reconsideration and Withdrawal of Finality. The Request was denied in an Advisory Action mailed on December 4, 2003 and applicants subsequently filed their Appeal Brief on December 30, 2003.

In a telephone interview on February 2, 2003, the second Examiner indicated that she would not prepare an Examiner's Answer for consideration of the Board of Patent Appeals and Interferences in the Appeal, but that "a new art rejection (i.e., a new combination of references) will be applied." A telephone call was made by the second Examiner to the undersigned attorney for applicants on March 10, 2004 in which it was indicated that there would not be a new art rejection as previously indicated, but that there would be a restriction requirement instead. Attorney for applicants objected to the restriction requirement in the telephone call as being untimely. Applicants subsequently requested reconsideration of the restriction requirement citing 37 CFR 1.142(a) and the Manual of Patent Examining Procedure (MPEP) 811.02.

The second Examiner proceeded to mail a fourth Office Action on March 12, 2004.² In part 1 on page 2, the Office Action stated, in part, that "[s]ince a new Examiner has taken over examination of the instant application and all previous art rejections are withdrawn, the present Examiner would like to start off examination with a clean slate." Parts 2-5 on pages 2-4 of the Office Action set forth the restriction requirement. In part 6 on pages 4-5, the Office Action acknowledged Applicants' request for reconsideration and gave reasons for insisting upon the restriction requirement.

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It is improper to make a Restriction Requirement after Appeal

There are several stages in the prosecution of a patent application before the U.S. Patent and Trademark Office. The last stage is the appeal of a final rejection to the Board of Patent Appeals and Interferences. See 35 U.S.C. 134. An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences may appeal directly to the U.S. Court of Appeals for the Federal Circuit. 35 U.S.C. 141. Although several current Patent Office regulations and policy are cited below as indicating that it is improper to delay a restriction requirement until after a final office action, applicants respectfully submit that there are still further reasons why a restriction requirement should not be made after appeal to the Board of Patent Appeals and Interferences.

The U.S. Patent Office has a continuing obligation to ensure the patentability of the claims in the applications that are allowed to issue as a patent. Thus, regulations currently exist that allow for the reopening of prosecution in an application appealed to the Board of Patent Appeals (see 37 CFR 1.191(e) and 1.198). However, none of the regulations indicate that prosecution of an appealed application may be reopened for the purpose of making a restriction requirement. Indeed, there is no obligation to ensure that every possible restriction requirement is made. The last sentence of 35 U.S.C. 121 explicitly states that the validity of a patent "shall not be questioned for failure of the Director to require the application to be restricted to one invention."

This distinction between the patentability of claims and restriction requirements is also reflected in the differing manner in which applicants may seek review of adverse decisions involving the patentability of claims and the restriction of claims. An appeal to the Board of Patent Appeals and Interferences can only be taken from rejections of claims (37 CFR 1.191), whereas a petition is

2 The Office Action has only the signature of the Examiner. It does not have the signature of a Supervisory

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necessary for the review of restriction requirements (37 CFR 1.144). There is no authority for the action taken in this application in which an appeal to the Board of Patent Appeals and Interferences is unilaterally terminated so that the Examiner may make a restriction requirement.

In addition to the above considerations, applicants respectfully submit that they will be unfairly disadvantaged by the restriction requirement. The restriction requirement, if upheld³, would require applicants to file divisional applications for the non-elected inventions. Applicants have already paid the Notice of Appeal fee and the fee for filing the Appeal Brief in this application. These fees will be applied if there is a later appeal in this application, but they will not be applied to any divisional application. Furthermore, applicants will apparently be entitled to a term extension of any patent issuing from this application, but it appears that such term extension will not be available to the divisional applications notwithstanding that applicants are not responsible for the delay in making the restriction requirement.

Finally, it must be acknowledged that the appeal of the final rejection of an application to the Board of Patent Appeals and Interferences is an advanced stage of prosecution beyond that of being after final. Applicants carefully considered the appeal in view of the alternatives such as filing a Request for Continued Examination or abandoning the application. Applicants took the additional expense and time necessary to have the rejections of the claims reviewed on the merits. In doing so, applicants rightfully expected that it would advance the prosecution of this application and would not result in receiving a restriction requirement that should have been made prior to the first office action on the merits. It is grossly unfair to now "start off examination with a clean slate" rather than to

Patent Examiner or a Technology Center Director.

³ Applicants reserve the right to file a Petition against the restriction requirement under 37 CFR 1.144 if this Petition is not granted or the restriction requirement is not otherwise withdrawn.

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present a new grounds of rejection that it is directed to the patentability of the claims and progresses the prosecution of this application.

The Restriction Requirement is a Violation of Due Process

Applicants respectfully submit that the new restriction requirement is a violation of procedural due process and of the Administrative Procedure Act. The only rationale offered for the delayed making of the restriction is that, because a new examiner has been assigned to this application, she should be allowed "to start off examination with a clean slate."⁴

While the Patent Office is certainly entitled to appoint different examiners to examine this application in its discretion, it is against stated policy for the appointment of a new examiner to be used as a reason that allows this application to be examined differently than other applications. To the contrary, "[f]ull faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something." (underlining added) MPEP 706.04. As mentioned above, applicants will be disadvantaged in several ways if the restriction requirement is made at this time.

Restriction after Final Action is contrary to 37 CFR 1.142(a)

37 CFR 1.142(a) states as follows:

⁴ It is unclear whether the Examiner is "new" since she: 1) mailed the third Office Action; 2) participated in a personal interview; 3) reviewed and entered a Supplemental Amendment to overcome a rejection under 35 U.S.C. 101; and 4) mailed an Advisory Action denying the Request for Reconsideration and Withdrawal of Finality, all

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"If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for a division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action." (underlining added)

As made clear in the Factual Background above, not one but three Office Actions on the merits were mailed in this application prior to the current Office Action containing the outstanding Restriction Requirement. Not only has there been a plurality of Office Actions on the merits, but there has been a final Office Action and the finality of that Office Action was maintained despite a Request for Withdrawal of Finality filed by Applicants. Also (as addressed further below), after the finality was insisted upon, the prosecution of this application then progressed to the point of an Appeal to the Board of Patent Appeals and Interferences and the filing of an Appeal Brief by applicants.

The Examiner acknowledges that there has been a final Office Action in this application and that the outstanding restriction requirement was made after that final Office Action, but asserts that restriction is nevertheless proper because "the Examiner has withdrawn finality of the last Office Action, the instant application now qualifies as 'before final action,' as set forth by the requirement of 37 CFR 1.142(a)." No authority is cited for this interpretation of the patent regulations.

The Examiner's interpretation ignores the plain language of the regulation. 37 CFR 1.142(a) clearly states that a restriction requirement may be made at any time before final Office Action. But the Examiner would have the regulation instead interpreted to permit a restriction requirement if the final Office Action had been made and then withdrawn. Such a standard could have been easily expressed by stating that a restriction requirement may be made at any time "except in" a final Office

before the Appeal Brief was filed.

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Action. But that is not the case and the Examiner's interpretation simply ignores the fact that the phrase "before final action" is used instead of "except in a final action."

Restriction After Final Action is Contrary to the MPEP

MPEP 811.02 states as follows:

"Since 37 CFR 1.142(a) provides that restriction is proper at any stage of prosecution up to final action, a second requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied." (citation omitted)(underlining added).

Although the Examiner addresses this section of the MPEP, she only acknowledges it only as relating to a second restriction requirement. However, MPEP 811.02 states that 37 CFR 1.142(a) provides that a restriction requirement "is proper at any stage of prosecution up to final action." It thus indicates that the proper interpretation of "before final action" in 37 CFR 1.142(a) is "up to final action" rather than "except in a final action" as suggested by the Examiner.

MPEP 811.02 further indicates that 37 CFR 1.142(a) provides for the "stage of prosecution" in which restriction requirement is proper. This focus on the stage of prosecution is consistent with other language in 37 CFR 1.142(a) which states that the restriction requirement will normally be made before any office action on the merits, with MPEP 810.02 which states that policy is to defer action on the merits until after the restriction requirement is complied with or withdrawn, and with MPEP 811 which states that the language in 37 CFR 1.142(a) means "the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops."

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Petition Fee

Applicant hereby authorizes and requests that the Petition Fee, or any other fee, necessary for the consideration of this Petition be charged to Deposit Account No. 02-4270 (6065/1).

Dated: April 12, 2004

Respectfully Submitted,

By:



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From: Robert M. Bauer, Esq. **Date:** April 12, 2004
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